

**REMARKS/ARGUMENTS**

Applicant notes that the subject matter of claim 31 has been identified as being allowable in the Office Action Summary and in paragraph 9 of the Detailed Action; however, claim 31 has been rejected in paragraph 8 of the Detailed Action.

**Claim Objections**

In paragraph 2 of the Detailed Action, the Examiner has rejected claims 37 to 39 and 41 to 43. To deal with this, the expression "A method" previously found in these claims has been replaced with "The method".

The Examiner is respectfully requested to withdraw his objection to claims 37 to 39 and 41 to 43.

**Claim Rejections - 35 U.S.C. 102**

In paragraph 4 of the Detailed Action, the Examiner has rejected claims 1 to 5, 11, 22 to 24, 26 to 28, 30, 36 to 38, and 40 to 42 under 35 U.S.C. 102(e) as being anticipated by United States Patent No. 6,549,768 (Fraccaroli). Given below is a brief description of the Present Invention and of the Fraccaroli reference, together with a discussion on how claims 1 to 5, 11, 22, to 24, 26 to 28, 30, 36 to 38, and 40 to 42 are patentable over the Fraccaroli reference.

**The Present Invention**

An apparatus for controlling data unit communications between a plurality of mobile stations is provided. Each mobile station has a respective maintained communication link with the apparatus. The apparatus has means for grouping at least two of the plurality of mobile stations as members of a private network group. The apparatus also has means for determining if a first mobile station sending a data unit and a second mobile station scheduled to receive the data are both members of the private network group. Finally, the apparatus has means for enabling communication of the data unit from the first mobile station to the second mobile station for the respective maintained communication links of the first mobile station and the second mobile station, only if they are both members of the private network group.

Fraccaroli

The Fraccaroli reference discloses computerized methods and systems for providing location-sensitive services in conjunction with a wireless communication network. In particular, the Fraccaroli reference discloses a computerized method and system of matching persons through their mobile stations on the network. A method of initiating contact between persons utilizing a wireless communications network on the basis of their physical location and a similarity of information which they have stored in the network is provided. Contact is initiated between people who don't personally know each other but who have both indicated an interest in meeting, or at least being put in contact with other people with similar interests. In another possible application of the invention, contact is initiated between people who might know each other but who don't know that they are both present at the same time in a certain area and who have indicated a willingness to be put in contact with each other when they are in a certain area at the same time.

Claim 1

Claim 1 is directed to an apparatus for controlling data unit communications between a plurality of mobile stations, each of the mobile stations having a respective maintained communication link with the apparatus, and recites:

"means for determining if a first mobile station sending a data unit and a second mobile station scheduled to receive the data unit are both members of the private network group".

The Examiner has referred to column 6, lines 34 to 59 of the Fraccaroli reference as disclosure for this claim feature and states that this passage recites "determining the position and hence the physical location of the user in order to determine whether the two mobile stations are both members of the private network group clearly anticipate the means for determining as now claimed". This passage refers to how handsets use location methods other than triangulation, such as adoption of a global positioning system (GPS) receiving device, to determine, or assist in the determination of location. With respect, this passage is silent on a means for determining if a first mobile station sending a data unit and a second mobile station scheduled to receive the data unit are both members of a private network group. Instead, the passage refers only to the use of a GPS to determine, or assist in the determination of, location.

Claim 1 also recites:

"means for enabling communication of the data unit from the first mobile station to the second mobile station through the respective maintained communication links of the first mobile station and the second mobile station only if they are both members of the private network group".

The Examiner has referred to column 9, line 50 to column 10, line 15 of the Fraccaroli reference as disclosure for this claim feature and states that this passage recites "constantly and automatically scanning for matching opportunities each time a user enter[s] a new location area whereby the user has the option to enable or disable matching so that in no case at the occurrence of a match, will the actual telephone number be exchanged automatically between two people without each of their permission clearly anticipate means for enabling communication only if they are both members of the network group". With respect, this passage refers to how matching profiles are treated, requested, enabled, and when telephone numbers are exchanged between people; however, there is no disclosure of any means for enabling communication of a data unit...through respective maintained communication links of the first mobile station and the second mobile station. In particular, as noted by the Examiner "the user has the option to begin enable or disable matching so that in no case at the occurrence of a match, will the actual telephone number be exchanged automatically between two people without each of their permission". As such, in the Fraccaroli reference before any communication links between two handsets can be established a telephone number has to be exchanged. Therefore, what is being disclosed is a method of exchanging telephone numbers and not means for enabling communication of the data unit...through respective maintained communication links of a first mobile station and a second mobile station.

Furthermore, the expression "a respective maintained communication link" first appears in the preamble of claim 1 and the Examiner has referred to column 5, lines 26 to 37 as disclosure for such a maintained communication link. In particular, the Examiner states "maintaining the user profile as long as the user is active in the service area clearly reads on the maintain communication link". With respect, "remaining active in a service area" does not equate to maintaining a communication link. In particular, the above passage discloses how a matching profile is maintained as long as a mobile station remains active. The mobile station could be

considered to be active if it regularly accesses the network in a plurality of sessions that are initiated and then terminated, and there is no reason to believe that "remaining active" equates with maintaining a communication link.

Thus, not all of the features of claim 1 are disclosed in the Fraccaroli reference.

The Examiner is respectfully requested to withdraw his 35 U.S.C. 102(e) rejection of claim 1.

Claims 11, 22, 28, 36, and 40

Claim 11 is directed to an apparatus for controlling data unit communications; claim 22 is directed to a private network; claim 28 is directed to a wireless network; claim 36 is directed to a method of enabling communication of a data unit; and claim 40 is directed to a method for controlling data unit communications. Each of these claims should be allowed for the same reasons as discussed above with reference to claim 1.

The Examiner is respectfully requested to withdraw the 35 U.S.C. 102(e) rejection of claims 11, 22, 28, 36, and 40.

Claims 2 and 37

Claims 2 and 37 depend on claims 1 and 36, respectively, and should be allowed for the same reasons as discussed above with reference to claims 1 and 36. Furthermore, claim 2 recites:

"wherein each of the mobile stations has a corresponding Home Location Registration (HLR)".

The Examiner has referred to column 4, lines 51 to 63 of the Fraccaroli reference as disclosure for this claim feature. With respect, this passage refers to home location registers 105 (see Figure 1 of the Fraccaroli reference) and not a Home Location Registration.

Claim 2 also recites:

"wherein the means for grouping at least two of the plurality of mobile stations as members of a private network group comprises means for listing the HLRs of the at least two mobile stations within a private network group table".

The Examiner has referred to a table in Figure 2 of the Fraccaroli reference as disclosure for this claim feature. With respect, the table of Figure 2 illustrates a profile and other information of a user page. The table of Figure 2 is described in column 8, line 50 to column 9, line 49 and there is no disclosure of any HRLs of at least two mobile stations within a private network group being listed.

Finally, claim 2 recites:

"wherein the means for determining if the first and second mobile stations are both members of the private network group comprises means for determining if the HRLs of the first and second mobile stations are both listed within the private network group table".

The Examiner has referred to column 4, lines 64 to column 5, line 11 of the Fraccaroli reference as disclosure for this claim features. With respect, this passage discloses how handsets register into a base station and how the ID (IDentification) of a handset can be sent to a MSC (Mobile Switching Center). With respect, again in this passage there is no disclosure of any HLRs or any disclosure of any private network group table.

Claim 37 should be allowed for the same reasons.

The Examiner is respectfully requested to withdraw the 35 U.S.C. 102(e) rejection of claims 2 and 37.

### Claim 3

Claim 3 depends on claim 2 and should be allowed for the same reasons as discussed above with reference to claim 2.

Furthermore, claim 3 further recites:

"wherein each of the mobile stations further has a corresponding data address and the data unit includes a data address corresponding to a desired destination mobile station as a destination address;

wherein the means for grouping at least two of the plurality of mobile stations as members of a private network group further comprises means for listing the data addresses of the

at least two mobile stations within the private network group table corresponding to their HLRs; and

wherein the means for determining if the first and second mobile stations are both members of the private network group further comprises means for determining the HLR of the second mobile station by looking-up the destination address of the data unit within the private network group table".

The Examiner has referred to column 4, lines 51 to 63; and column 4, line 64 to column 5, line 11 of the Fraccaroli reference as disclosure for this claim feature and states that these passages recite "forming groups of mobile stations using the HLR; Fig. 2 which shows table of user page including profiles and parameters". As discussed above with reference to claim 2, there is no disclosure of HLRs (Home Location Registrations). Furthermore, as discussed above with reference to claim 2, the table referred to in Figure 2 of the Fraccaroli reference is not a private network group table listing HLRs of mobile stations. As such, there is no disclosure of any means for listing the data addresses of the at least two mobile stations within the private network group table corresponding to their HLRs. Furthermore, the Examiner has also referred to column 6, lines 34 to 59 as disclosure for this claim feature and states that this passage recites "determining the position and hence the physical location of a user in order to determine whether the two mobile stations are both members of the private network group". With respect, this has nothing to do with determining the HLR of the second mobile station by looking-up a destination address of the data unit within the private network group table.

None of the additional features of claim 3 are disclosed by the Fraccaroli reference.

The Examiner is respectfully requested to withdraw his U.S.C. 102(e) rejection of claim 3.

#### Claim 4

Claim 4 depends on claim 3 and should be allowed for the same reasons as discussed above with reference to claim 3. Furthermore, claim 4 recites:

"wherein the data addresses are Internet Protocol (IP) addresses".

The Examiner has referred to column 8, lines 33 to 56 of the Fraccaroli reference as disclosure

for this claim feature; however, Applicant cannot find any disclosure of any such feature in this passage.

The additional claim feature of claim 4 is not disclosed in the Fraccaroli reference.

The Examiner is respectfully requested to withdraw his 35 U.S.C. 102(e) rejection of claim 4.

Claim 5

Claim 5 depends on claim 1 and should be allowed for the same reasons as discussed above with reference to claim 1. Furthermore, claim 5 recites:

"wherein the means for grouping at least two of the plurality of mobile stations as members of a private network group comprises means for listing the node registrations of the at least two mobile stations within a private network group table".

The Examiner has referred to a table in Figure 2 of the Fraccaroli reference as disclosure for this claim feature. With respect, the table of Figure 2 illustrates a profile and other information of a user page. The table of Figure 2 is described in column 8, line 50 to column 9, line 49 and there is no disclosure of any node registrations of at least two mobile stations within a private network group being listed.

Thus, at least some of the additional claim features of claim 2 are not disclosed in the Fraccaroli reference.

The Examiner is respectfully requested to withdraw the 35 U.S.C. 102(e) rejection of claim 5.

Claim 23

Claim 23 depends on claim 22 and should be allowed for the same reasons as discussed above with reference to claim 22. Furthermore, claim 23 should be allowed for the same reasons as discussed above with reference to claim 5.

The Examiner is respectfully requested to withdraw the 35 U.S.C. 102(e) rejection of claim 23.

Claims 24 and 26

Claims 24 and 26 depend on claim 22 and should be allowed for the same reasons as discussed above with reference to claim 22. The Examiner is respectfully requested to withdraw the 35 U.S.C. 102(e) rejection of claims 24 and 26.

Claim 27

Claim 27 depends on claim 22 and should be allowed for the same reasons as discussed above with reference to claim 22. Furthermore, claim 27 recites the additional claim feature:

“wherein at least one of the plurality of apparatus is a server coupled to a Local Area Network (LAN)”.

The Examiner has referred to column 4, line 64 to column 5, line 11 of the Fraccaroli reference as disclosure for this claim feature. With respect, in this passage there is no disclosure of any Local Area Network (LAN).

The Examiner is respectfully requested to withdraw the 35 U.S.C. 102(e) rejection of claim 27.

Claim 38

Claim 38 depends on claim 36 and should be allowed for the same reasons as discussed above with reference to claim 36. Furthermore, claim 38 should be allowed for the same reasons as discussed above with reference to claim 5.

The Examiner is respectfully requested to withdraw the 35 U.S.C. 102(e) rejection of claim 38.

Claim 41

Claim 41 depends on claim 40 and should be allowed for the same reasons as discussed above with reference to claim 40. Furthermore, claim 41 should be allowed for the same reasons as discussed above with reference to claim 2.

The Examiner is respectfully requested to withdraw the 35 U.S.C. 102(e) rejection of claim 41.

Claim 42

Claim 42 depends on claim 40 and should be allowed for the same reasons as discussed above with reference to claim 40. Furthermore, claim 42 should be allowed for the same reasons as discussed above with reference to claim 5.

The Examiner is respectfully requested to withdraw the 35 U.S.C. 102(e) rejection of claim 42.

Claim Rejections – 35 U.S.C. 103

In paragraph 7 of the Detailed Action, the Examiner has rejected claims 12 to 15 and 17 under 35 U.S.C. 103(a) as being unpatentable over the Fraccaroli reference in view of United States Patent No. 5,995,923 (Mermelstein *et al.*).

Statement Concerning Common Ownership

The present application and United States Patent No. 5,995,923 (Mermelstein *et al.*) were at the time the invention of the present application was made, owned by Nortel Networks Limited.

Note that the assignee in the United States Patent No. 5,995,923 (Mermelstein *et al.*) is in the name of Nortel Networks Corporation which has undergone a change of name to Nortel Networks Limited.

Since the present application and U.S. Patent No. 5,995,923 were at the time the invention of the present application was made, owned by Nortel Networks Limited, and since U.S. Patent No. 5,995,923 is citable only under 35 U.S.C. 102(e) this reference is not citable under 35 U.S.C. 103(a) (see 35 U.S.C. 103(c)).

The Examiner is respectfully requested to withdraw the 35 U.S.C. 103(a) rejection of claims 12 to 15 and 17.

In paragraph 8 of the Detailed Action, the Examiner has rejected claim 31 under 35 U.S.C. 103(a) as being unpatentable over the Fraccaroli reference in view of United States Patent No. 6,249,584 (Hämäläinen *et al.*).

There are three requirements for establishing a *prima facie* case of obviousness: 1) all features must be present; 2) there must be an expectation of a reasonable chance of success; and 3) there must be some suggestion or motivation in the prior art to combine the references.

Claim 31 depends on claim 28 and should be allowed for the same reasons as discussed above with reference to claim 28. In particular, as discussed above with reference to claim 28, the Fraccaroli reference fails to disclose all of the claim features of base claim 28 and Applicant submits that the Hämäläinen *et al.* reference also fails to disclose the claim features of base claim 28 that the Fraccaroli reference fails to disclose. As such, requirement 1) for a *prima facie* case of obviousness is not satisfied.

Furthermore, since not all claim features of claim 31 are disclosed by the cited references there is no reason to believe that a combination of teachings from the Fraccaroli and Hämäläinen *et al.* references produces an expectation of a reasonable chance of success, and requirement 2) for a *prima facie* case of obviousness is not satisfied.

Finally, the Hämäläinen *et al.* reference discloses a method for indicating and ciphering of data transmission between a mobile communication network and a mobile station. With respect, this has nothing to do with the solution provided by the present invention nor does this have anything to do with the disclosure of the Fraccaroli reference. The Examiner is simply combining teachings from two references that solve completely different problems from completely different fields and there is no suggestion or motivation to combine these references. As such, requirement 3) for a *prima facie* case of obviousness is not satisfied.

None of the requirements for a *prima facie* case of obviousness are satisfied.

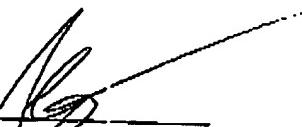
The Examiner is respectfully requested to withdraw the 35 U.S.C. 103(a) rejection of claim 31.

Applicant appreciates the Examiner's comment in paragraph 9 of the Detailed Action which indicates that claims 6 to 10, 16, 18 to 21, 25, 29, 32 to 35, 39, and 43 would be allowable if rewritten to include all of the limitations of the base claim and any intervening claims; however, given the above discussion in favour of the base claims Applicant elects to leave these claims unamended.

The Examiner is respectfully requested to pass this application to allowance but, if there are any outstanding issues, the Examiner is respectfully requested to telephone the undersigned.

Respectfully submitted,

MITCH A. BRISEBOIS

By 

Allan Brett

Reg. No. 40,476

Tel.: (613) 232-2486 ext. 323

Date: September 17, 2004  
RAB:MPP:acb